

## **REMARKS**

In the Final Office Action mailed on August 17, 2010, all of pending claims 1, 3-6, 9-21 and 26-30 stand rejected.

To expedite prosecution, independent claim 1 has been amended to incorporate the features of defendant claim 16, which has been canceled.<sup>1</sup> Accordingly, claim 17 has been amended to depend from amended claim 1 instead of canceled claim 16.

Reconsideration of the pending claims in view of the following remarks is respectfully requested.

### **I. 35 U.S.C. 102 Rejections**

Claims 1, 3-6, 9-15, 18-21 and 26-27 stand rejected under 35 U.S.C. 102(b) as being anticipated by WO 98/47974 (“Heyenk”) as evidenced by U.S. 6,235,102 (“Parekh”).

As amended, independent claims 1 and 20 recite a can, or method of making a can, in which at least one body or end portion is coated with a coating composition that includes, among other things, a blend of polyesters in combination with 2 to 10 weight percent acrylate copolymer, based on solids contents. The Heyenk reference does not teach a coating combination that includes a polyester blend and an acrylate copolymer, let alone 2 to 10 weight percent acrylate copolymer. Thus, it is respectfully submitted that claims 1, 3-6, 9-15, 18-21 and 26-27 are not anticipated by Heyenk.

It is further noted that, for the reasons already discussed extensively on the record, the Heyenk record does not include an anticipatory disclosure of the polyester blend recited in claim 1.<sup>2</sup>

### **II. 35 U.S.C. 103 Rejections**

The Final Office Action at page 6, item 14, asserts that claims 1, 3-6, 9-17, 18-21, 26, 27, 29 and 30 are unpatentable over the Heyenk and Parekh references.

As previously discussed, independent claims 1 and 20 have been amended to incorporate the features of cancelled claim 16. As amended, claims 1 and 20 recite that the coating composition includes 2 to 10 weight percent acrylate copolymer, based on solids contents.

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<sup>1</sup> Applicants reserve the right to file a continuing application with claims directed to the subject matter of claim 1 prior to entry of this Amendment.

<sup>2</sup> See, e.g., pages 6-8 of Applicant’s Response “G” dated June 8, 2010.

Independent claim 30 recites a can including a coating composition that comprises, among other things, an acrylate copolymer having pendant glycidyl groups.

According to the Final Office Action, Heyenk teaches all of the features recited in the claims “but is silent regarding the addition of an acrylate copolymer having glycidyl groups and the Tg of the second polymer being between 15 and 25°C.” The Final Office Action looks to the secondary Parekh reference and asserts that a skilled artisan would have been motivated to include a acrylate copolymer having glycidyl groups in the Heyenk coating composition to improve the corrosion barrier properties of the coating. Although Heyenk does not disclose any corrosion issues, section 39 of the Final Office Action asserts that “[i]t is common-sensical to want to improve the corrosion resistance of a coating, even absent an explicit teaching.” The secondary Parekh reference teaches a multi-coat system for use on metal closures (or lids) of glass or plastic food containers, which includes a primer coat such as an epoxy-phenolic-based primer in combination with a top coat that is free of vinyl halides (unlike certain conventional closure systems that included a vinyl-halide-based top coat such as a polyvinyl-chloride-based top coat).<sup>3</sup> The Parekh topcoat includes, among other things, about 50% to about 90%, by weight nonvolatile material, of an acrylate copolymer having pendant glycidyl groups and about 10% to about 50%, by weight nonvolatile material, of an acid-terminated polyester.<sup>4</sup>

Although the Parekh reference does not teach including less than 50%, by weight of nonvolatile material, of acrylate copolymer in the coating composition, the Final Office Action nonetheless asserts in section 24 that:

*“It would have been obvious to one having ordinary skill in the art at the time the invention was made to have optimized the amount of acrylate copolymer added to the polyester composition in order to optimize the corrosion resistance of the composition. Such an optimization would have resulted in the invention claims in claims 16 and 17.”*

Applicants respectfully traverse the rejection of former claims 16 and 17 to the extent it is applicable to the amended claims.

The Final Office Action’s obviousness rejection of former claims 16 and 17 is based on an obvious-to-try rationale. For a claim to be properly rejected under such a

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<sup>3</sup> See, e.g., col 15, lines 32-34.

<sup>4</sup> See col. 5, lines 52-59.

rationale, the proposed combination must be chosen from a finite number of identified, predictable solutions.<sup>5</sup> “Under the Federal Circuit’s case law “finite” means “small or easily traversed” [number of solutions] in the context of the art in question.”<sup>6</sup> In addition, such a skilled artisan must have reasonably expected that the proposed combination would have worked for its intended purpose.<sup>7</sup>

Even *arguendo* if a skilled artisan were to look to improve the corrosion resistance of the Heyenk coating,<sup>8</sup> the relevant prior art does not include a “small or easily traversed” number of identified, predictable solutions for enhancing the corrosion resistance of the Heyenk coating. Rather, the prior art includes a near limitless number of possible solutions, which are unpredictable both in terms of the effects on corrosion resistance as well as the balance of other desired coating properties. (The Parekh reference itself teaches that “often improving one particular advantageous property is achieved at the expense of another advantageous property.”<sup>9</sup>) A skilled artisan would have had no reason to focus on or select the Parekh reference out of the vast multitude of coating references present in the prior art that teach a coating composition generically asserted to have good corrosion resistance, let alone focus on the acrylate copolymer of the topcoat of the Parekh multi-coat system as a corrosion resistance additive.

It is pure speculation on the part of the Final Office Action that addition of the Parekh acrylate copolymer to the Heyenk coating composition would improve the corrosion resistance of the Heyenk coating, let alone that it would improve the corrosion resistance without unsuitably degrading other coating properties (e.g., flexibility, adhesion, appearance, etc.). Nonetheless, the Final Office Action asserts that “[t]he composition of Parekh inhibits corrosion of metals by simply admixing the acrylate copolymer with pendant glycidyl groups with polyester. It follows that the addition of

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<sup>5</sup> See, e.g., the 2010 Obviousness Guidelines (Federal Register, Vol. 75, No. 169, Wednesday, September 1, 2010) at p. 53660, in summarizing a teaching point from *Rolls-Royce, PLC v. United Technologies Corp.*, 603 F.3d 1325 (Fed. Cir. 2010) states that “[a]n obviousness to try rationale may be proper when the possible options for solving a problem were known and finite. However, if the possible options were not either known or finite, then an obvious to try rationale cannot be used to support a conclusion of obviousness.”

<sup>6</sup> See, e.g., the 2010 Obviousness Guidelines at p. 53655.

<sup>7</sup> See, e.g., the 2010 Obviousness Guidelines at item C. on p. 53654 which states that “As in *DePuy Spine*, whether the combination would predictably be effective for its intended purpose is part of the obviousness analysis.”

<sup>8</sup> Applicants traverse the assertion that a skilled artisan would have been motivated to improve the corrosion resistance of the Heyenk coating, especially given that Heyenk neither discloses nor suggests any deficiency in corrosion resistance.

<sup>9</sup> See col. 1, lines 38-41.

acrylate copolymer with pendant glycidyl groups would therefore improve the corrosion barrier properties of other polyesters.” Applicants respectfully submit that this argument is based on a flawed premise and, moreover, draws a conclusion that does not follow from even the flawed premise.

Regarding the flawed premise, while Parekh generically states that the coating system described therein has good corrosion resistance, the corrosion resistance is reported in the context of a multi-coat system that also includes a closure-type primer layer such as an epoxy-phenolic layer. In fact, Parekh suggests that the corrosion resistance properties are largely attributable to the primer layer.<sup>10</sup> Consequently, the Final Office Action’s assertion that the Parekh composition inhibits corrosion of metals by simply admixing an acrylate copolymer of the topcoat with polyester is not accurate.

Moreover, there is no basis for concluding that the acrylate copolymer of the Parekh topcoat improves the corrosion resistance of the polyester polymer of the Parekh topcoat, let alone that it would improve the corrosion resistance of the Heyenk polyester coating. Contrary to the assertions of the Final Office Action, that (i) the multilayer Parekh coating is reported to inhibit corrosion of metal substrate and (ii) the Parekh topcoat includes a majority of acrylate copolymer and a minority of polyester polymer in no way suggests that the acrylate copolymer has some sort of general utility as a corrosion resistance additive for polyester coatings. Based on the teachings of Parekh, a skilled artisan could only speculate as to the effect that the addition of the Parekh acrylate copolymer would have on the corrosion resistance properties of the Heyenk coating. Given that Parekh teaches that its topcoat should include from about 50 to 90%, on solids, of acrylate copolymer, and 60-70% “[t]o achieve the full advantages of the invention,”<sup>11</sup> the teachings of Parekh would in fact discourage a skilled artisan from adding 2 to 10% of the Parekh acrylate copolymer to the Heyenk coating composition.

Thus, for the foregoing reasons, it is respectfully submitted that a skilled artisan considering the Heyenk reference would not be motivated to look to the secondary Parekh reference in the first place; and, moreover, a skilled artisan would likewise have no reasonable expectation of success that the addition of the Parekh acrylate copolymer

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<sup>10</sup> See, e.g., col. 14, lines 41-60.

<sup>11</sup> See col. 7, lines 50-56.

to the Heyenk coating composition would yield improved corrosion resistance while preserving the balance of other coating properties.

For the reasons already of record, it is further noted that the proposed combination of Heyenk in view of Parekh would not yield the instantly claimed invention given that Heyenk does not disclose a coating composition having the recited blend of polyesters. The instant claims include a polyester blend that includes between about 60 and 90 weight percent polyester resin having a Tg less than about 25°C. Contrary to the assertions of the Final Office Action, 37 weight percent is the highest concentration of polyester polymer having a Tg of less than 25°C disclosed in Heyenk.<sup>12</sup>

With regards to the rejection of claim 28 over Heynk as evidenced by Parekh and U.S. 5,252,669 (“Maska”), the Maska reference does not overcome the deficiencies in the Heyenk and Parekh references.

Accordingly, it is respectfully submitted that all of the pending claims are allowable over the Heyenk, Parekh, and Maska references.

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<sup>12</sup> See Applicants’ Response “B” which includes a table on page 8 showing the Tg’s and weight percents of the polyesters included in the coating compositions of the Heyenk worked examples.

## **CONCLUSION**

In view of the foregoing, Applicants respectfully submit that all of pending claims 1, 3-6, 9-15, 17-21, and 26-30 are in condition for allowance. A notice to that effect is respectfully requested. The Commissioner is authorized to charge any additional fees associated with this paper or credit any overpayment to Deposit Account No. 50-2070.

Respectfully submitted,

VALSPAR SOURCING, INC.

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By: /Andrew A. DeMaster/  
Andrew A. DeMaster, Reg. No. 57326  
PO Box 1461  
Minneapolis, MN 55440  
Telephone: (612) 851-7281  
Fax: (612) 486-7979